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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,788	09/29/2003	Fumihito Imai	Q77629	1491

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EXAMINER

WATKO, JULIE ANNE

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/671,788	<b>Applicant(s)</b> IMAI, FUMIHITO	
	<b>Examiner</b> Julie Anne Watko	<b>Art Unit</b> 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings are objected to because:

Figures 8B-8C are not separately labeled, insofar as these figures include two figures each. The Examiner suggests relabeling these figures as Figs. 8B-8E, and amending the specification accordingly.

Figures 9-13B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

3. The disclosure is objected to because of the following informalities: On page 7, line 24- page 8, line 1, the specification recites “Figures 8B and C are a perspective view and a plan view showing the engaging member, respectively.” This is inconsistent with the appearance of Figs. 8B-8C, because Fig. 8B shows a plan view in addition to the perspective view, and because Fig. 8C shows a perspective view in addition to the plan view. The Examiner suggests amending the specification as described above in the objection to the drawings.

Appropriate correction is required.

4. The use of the trademark HYTREL has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Objections*

5. Claims 1 and 3 are objected to because of the following informalities:

Claim 1 recites the limitation “the surface” in lines 10-11. No “surface” has been previously recited. The Examiner suggests the limitation --[the] a surface of X--, wherein X is a particular part of the claimed product.

Claim 3 recites the limitation “wherein the engaging protrusion ... is integrally formed with the engaging protrusion.” In accordance with Applicant’s apparent intent, the Examiner

suggests -- wherein the engaging protrusion which is separately formed from the frame, is coupled to the frame through a thin portion having elasticity, [and] wherein said thin portion is integrally formed with the engaging protrusion.--

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani et al (US Pat. No. 5903541).

As recited in claim 1, Mizutani et al show a disk cartridge (see Fig. 5, for example) which rotatably houses a disk 2 serving as a recording medium in a flat housing 1 constituted of a frame 7 and upper and lower shells (including 25 and 26, respectively) covering a top and a bottom of the frame, wherein an engaging protrusion 23 is provided on at least one of either top or bottom side of the frame, and an engaging aperture (27 or 29, for example) which engages with the engaging protrusions is formed on at least one the upper and lower shells, the engaging protrusion 23 being able to freely oscillate in and out from the surface (of the frame 7, see Fig. 2) and being elastically urged ("the breakable connecting piece 24 is elastically deformed, but not being broken, to allow the truncated cone 23a to pass underneath to engage in or disengage from the top hole 27", see col. 5, lines 33-36) in a direction in which the engaging protrusion protrudes from the surface.

The product by process limitations in these claims (e.g., “the housing is assembled by ...”) are directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final structure of the product “gleaned” from the process limitations or steps, which must be determined in a “product by process” claim, and not the patentability of the process limitations. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in “product by process” claims or not. Note that the applicant has the burden of proof in such cases, as the above case law makes clear.

As recited in claim 1, Mizutani et al are silent regarding whether said shells are made of metal plates.

Official notice is taken of the fact that the use of metals in disc cartridges was known in the art at the time the invention was made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plates of Mizutani et al of metal plates as is notoriously well known in the art. The rationale is as follows: one of ordinary skill in the art would have been motivated to provide electromagnetic shielding as is notoriously well known in the art.

As recited in claim 2, Mizutani et al show that the engaging protrusion 23 is coupled to the frame through a thin portion 24 which has elasticity (“the breakable connecting piece 24 is elastically deformed, but not being broken, to allow the truncated cone 23a to pass underneath to

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engage in or disengage from the top hole 27”, see col. 5, lines 33-36), wherein the thin portion is integrally formed with the engaging protrusion and the frame. (The limitation “integrally formed” is given its broadest reasonable interpretation, which does not require one-piece formation, even though one-piece formation is a matter of obvious design choice. See *In re Larson, Russler, and Meldahl*, 144 USPQ 347 (CCPA 1965). The mere fact that a given structure is integral does not preclude its consisting of various elements. See *Nerwin v. Erlichman*, 168 USPQ 177 (BPAI 1969). Furthermore, there is no invention in integration or separation of parts, absent evidence of unexpected results due to the integration or separation, provided that the integration or separation was within the level of ordinary skill in the art at the time. See *In re Fridolph*, 135 USPQ 319 (CCPA 1962).)

As recited in claim 2, Mizutani et al are silent regarding whether the frame is of synthetic resin.

Official notice is taken of the fact that the use of synthetic resin was known in the art at the time the invention was made.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the frame of synthetic resin. The rationale is as follows: one of ordinary skill in the art would have been motivated to achieve desired weight, moldability, flexibility, durability, and other desired material characteristics as is notoriously well known in the art.

As recited in claim 3, Mizutani et al show that the engaging protrusion 23 is coupled to the frame 7 through a thin portion 24 having elasticity, wherein the thin portion is integrally formed with the engaging protrusion. (The limitation “integrally formed” is given its broadest reasonable interpretation, which does not require one-piece formation, even though one-piece

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formation is a matter of obvious design choice. See *In re Larson, Russler, and Meldahl*, 144 USPQ 347 (CCPA 1965). The mere fact that a given structure is integral does not preclude its consisting of various elements. See *Nerwin v. Erlichman*, 168 USPQ 177 (BPAI 1969).)

As recited in claim 3, Mizutani et al do not explicitly show that the engaging protrusion is separately formed (see above regarding product-by-process limitations) from the frame.

There is no invention in integration or separation of parts, absent evidence of unexpected results due to the integration or separation, provided that the integration or separation was within the level of ordinary skill in the art at the time. See *In re Fridolph*, 135 USPQ 319 (CCPA 1962).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to separate the frame from the engaging protrusion and the thin portion. The rationale is as follows: one of ordinary skill in the art would have been motivated to separately optimize the materials for weight, elasticity, rigidity, durability, and other desired material characteristics of the various parts as is notoriously well known in the art.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goto et al (US Pat. No. 6078563) show a disk cartridge comprising stopping bar 23 (see Fig. 4; see also col. 8, lines 10-26, "Reference numeral 23 is a stopping bar disposed at a position symmetrical to central axis A--A (see FIG. 5) passing through the opening 9, and in the assembled state of the cartridge, it is means for fixing the lid 17 to the case main body 2, by engagement with a stopping hole 24 provided individually in the upper half 3 and lower half 4. As shown in FIG. 4, meanwhile, the stopping bar 23 is formed of resin integrally with the lid 17,



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and is coupled with the lid 17 through a thin wall portion, and the side to be engaged with the stopping hole 24 has a groove to be engaged with the leading end of the screw driver, while the other side is inserted into a discharge hole 25 provided individually in the upper half 3 and lower half 4, and the discharge hole is clogged while fitting with the discharge hole. By inserting the leading end of a screwdriver into the groove of the stopping bar 23 and rotating, the thin wall portion is divided, and the stopping bar 23 can be detached from the discharge hole 25.”).

Hitachi/Nintendo (GB 2273601 A) shows a disk cartridge (see Fig. 1; see especially p. 11, lines 1-8, “Elastic members 134 which correspond to the tray locking holes 112 are provided in two positions separated on the right and left in this side on the upper surface of the tray 130. Slits 135 are formed around the elastic members 134 so that they are displaced to have the elastic force when being pressed. Locking projections 136 for engaging with the tray locking holes 112 are provided on the upper surfaces of the elastic members”; see also p. 10, lines 3-5, “case 101 includes an upper half 110 and a lower half 120 made of the synthetic resin”).

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597.

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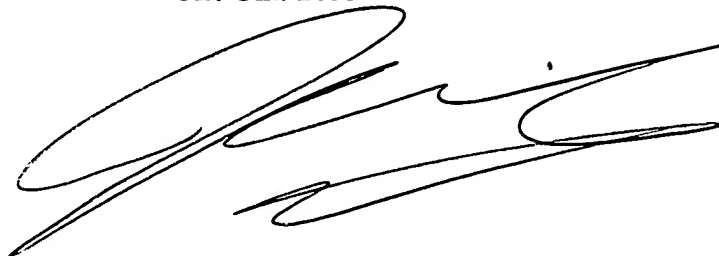
The examiner can normally be reached on T11A-5P W3P-9P Th11:30A-10P F10A-8:30P

SatNoon-8:30P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko  
Primary Examiner  
Art Unit 2653

February 24, 2006  
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', is written over the printed name and title.